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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,710	02/03/2004	Yung-Hsiang Chen	USP2323A-SGH(2)	4136

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EXAMINER

STAICOVICI, STEFAN

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/771,710

Applicant(s)

CHEN, YUNG-HSIANG

Examiner

Stefan Staicovici

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 16-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10 is/are rejected.
- 7) ☒ Claim(s) 9, 11-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/3/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-15, drawn to a method of manufacturing a golf club grip, classified in class 264, subclass 257.
 - II. Claims 16-25, drawn to golf club grip, classified in class 473, subclass 300.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as compression molding the textile fabric and a rubber layer and then machining a layer of rubber to expose fibers of the textile fabric.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. Raymond Chan on February 28, 2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 16-25 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested:

“Method of Making a Golf Club Grip with Anti-Slip and Control Arrangement”.

6. The abstract of the disclosure is objected to because the patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. Hence, the abstract should include a concise statement showing a method for making a golf club grip. Correction is required. See MPEP § 608.01(b).

7. The disclosure is objected to because of the following informalities:

- on page 1, line 13, after “matter”, --whether-- should be included;

- on page 1, line 26, before “right”, “here” should be replaced with --her--.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 3-4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lamkin *et al.* (US Patent No. 6,666,777 B1) in view of Li *et al.* (US Patent No. 6,686,301 B2).

Lamkin *et al.* ('777) teach the basic claimed process for making a grip for a golf club including, providing an upper and a lower mold (56, 58), positioning a first strip of rubber material having a fabric embedded therein (52) (anti-slip members) and second strip of rubber material (50) (control members) in abutting relationship (coaxially) into said lower mold (56) to form a lower arrangement, placing a mandrel over said lower arrangement, placing a third rubber strip (54) over said mandrel (80) to form a molded assembly, applying heat and pressure to vulcanize said rubber material and form an integrated golf club grip (see col. 4, lines 51-65; col. 5, lines 15-18 and 29-56; col. 6, line 31 through col. 7, line 18).

Regarding claim 1, although Lamkin *et al.* ('777) teach pre-molding a fabric embedded in a rubber strip, Lamkin *et al.* ('777) do not teach coating a textile fabric with a latex rubber to attach said textile fabric with a rubber strip. Li *et al.* ('301) teach a process for bonding a textile fabric with a rubber strip including, coating said fabric with a latex solution and heat curing said latex in order to bond said textile fabric with said rubber strip (see Abstract and col. 5, lines 17-33). Therefore, it would have been obvious for one of ordinary skill in the art to have attached a textile fabric to a rubber strip by coating said textile fabric with a latex rubber as taught by Li *et al.* ('301) in the process of Lamkin *et al.* ('777) because, Li *et al.* ('301) teach that said a process promotes the adhesion of the fabric to the rubber, hence providing for durable, long-lasting textile reinforcement and also because, Lamkin *et al.* ('777) specifically teach pre-molding a fabric embedded in a rubber strip, hence requiring the teachings of Li *et al.* ('301) in order to function as described.

In regard to claims 3-4, Lamkin *et al.* ('777) teach a grip for a golf club having an anti-slip component and a control component. Hence, it is submitted that the grip length must be such

that said grip functions as a grip for a golf club, hence functions as described by Lamkin *et al.* ('777).

Specifically regarding claim 8, Lamkin *et al.* ('777) teach that said textile fabric is cotton or a cotton-based fabric (see col. 4, lines 60-63).

10. Claims 2, 5-7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lamkin *et al.* (US Patent No. 6,666,777 B1) in view of Li *et al.* (US Patent No. 6,686,301 B2) and in further view of Minami (US Patent No. 5,322,290).

Lamkin *et al.* ('777) in view of Li *et al.* ('301) teach the basic claimed process as described above.

Regarding claim 2, Lamkin *et al.* ('777) in view of Li *et al.* ('301) do not teach multiple rubber layers. Minami ('290) teaches a golf club grip having multiple rubber layers (see col. 1, line 58 through col. 2, line 42). Therefore, it would have been obvious for one of ordinary skill in the art to have provided multiple rubber layers as taught by Minami ('290) to the golf grip formed by the process of Lamkin *et al.* ('777) in view of Li *et al.* ('301) because, Minami ('290) teaches that multiple rubber layers provides a golf club grip that can suppress at the same time the bending, torsional and elongative deformation, when swinging said club, hence providing for an improved product.

In regard to claim 5, Lamkin *et al.* ('777) in view of Li *et al.* ('301) and in further view of Minami ('290) teach a grip for a golf club having an anti-slip component and a control component. Hence, it is submitted that the grip length must be such that said grip functions as a grip for a golf club, hence functions as described by Lamkin *et al.* ('777).

Specifically regarding claims 6-7, Lamkin *et al.* ('777) teach painting said molded golf club grip having an anti-slip region and a control region (see col. 7, lines 37-41). Further, Minami ('290) teaches painting a golf club grip into different colors in order to provide a mark for positioning the player's hands or fingers on said grip (see col. 2, lines 37-43). Therefore, it would have been obvious for one of ordinary skill in the art to have painted a golf club grip in different colors as taught by Minami ('290) in the process of Lamkin *et al.* ('777) in view of Li *et al.* ('301) because Minami ('290) teaches that painting of a golf club grip into different colors provides a mark for positioning the player's hands or fingers on said grip, hence providing for an improved product.

Regarding claim 10, Lamkin *et al.* ('777) teach that said textile fabric is cotton or a cotton-based fabric (see col. 4, lines 60-63).

Allowable Subject Matter

11. Claims 9 and 11-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefan Staicovici, Ph.D. whose telephone number is (571) 272-1208. The examiner can normally be reached on Monday-Friday 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Colaianni, can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stefan Staicovici, PhD



Primary Examiner

3/28/05

AU 1732

March 28, 2005